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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1947.

No. 558

GENERAL MOTORS CORPORATION,
Petitioner,

vs.

ELMER G. KESLING,
Respondent.

PETITION FOR REHEARING OF PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE EIGHTH CIRCUIT AND BRIEF IN SUPPORT THEREOF.

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To the Honorable, the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your Petitioner, General Motors Corporation, respectfully prays for rehearing of the Petition for a Writ of Certiorari heretofore filed herein, and under Rule 33 of this Court as amended October 13, 1947, shows as grounds thereof not previously presented:

1. The Eighth Circuit Court of Appeals has in this case laid down a test for the construction of a patent that violates the statute (Title 35, U. S. Code, Sec. 33), saying:

"Broad as is the language of these claims, their scope depends upon the discovery revealed in the explanatory Specifications." (R. 680)

• • •

"(1). The patent nowhere contains the word 'feel.' (R. 682)

• • •

"Summary of Scope of Patent. The scope of a patent is not a mathematical measurement. It is a **conception** reached by consideration of the combined effects of the state of the art, the contributions as revealed in the language of the patent to one skilled in the art, and any limitations imposed and accepted during the progress of the application through the Patent Office (*Smith* v. *Mid-Continent Inv. Co.*, 8 Cir., 106 F. (2d) 622, 624). (R. 684)

• • •

"While he cannot claim all manner of construction which will apply this principle of hand feel and control because of his own expressed limitations of 'objects;' on the other hand, because he uncovered this governing principle of the way to solve the problem of utilizing power in such gear shifts and has shown the way he thought to be the best solution, he is entitled to a reasonably liberal range of protection." (R. 686)

2. The Patent Act requires and this Court has repeatedly held, "The scope of every patent is limited to the claims contained in it, read in the light of the specification."

Motion Picture Patents Co. v. *Universal Film Mfg. Co.*, 243 U. S. 502, 510.

and • • • "the precise terms of the grant define the limits of a patentee's monopoly" • • • and "patent grants are to be construed strictly," • • •

United States v. *Line Material Co.*, ... U. S. .....; 76 U. S. P. Q. 399, 405, 407, (decided March 8, 1948).

In *Altoona Publix Theatres* v. *American Tri-Ergon Corp.*, 294 U. S. 477, 487, this Court said:

> "(3-4) The Court of Appeals, in upholding the patent, made no examination of its separate claims, but treated the patent throughout as though it were a combination of five distinct elements, the photo-electric cell, the arcuate flexing of the film, the fly-wheel, and the optical slit, although nowhere in the patent is any such combination claimed. The patent thus upheld is one which was neither claimed nor granted. *Under the statute, it is the claims of the patent which define the invention.* And each claim must stand or fall, as itself sufficiently defining invention, independently of the others." (Emphasis added).

In *Universal Oil Prod. Co.* v. *Globe*, 322 U. S. 471, 484-485, this Court said:

> "The claim is the measure of the grant. • • • The claim is required to be specific for the very purpose of protecting the public against extension of the scope of the patent."

3. Practically every Circuit Court of Appeals has similarly held that "The monopoly of a patent is limited in its scope to the claims thereof."

> *Braun* v. *John Griffiths & Son Co.*, 234 F. 636, 639 (C.C.A. 7).
>
> "Claims can be no broader than the invention as disclosed."
>
> *Baker Perkins Co.* v. *Thomas Roulston, Inc.*, 62 F. (2d) 509, 513, (C.C.A. 2).
>
> *H. Schindler & Co.* v. *Saladino & Sons*, 81 F. 649, 654 (C.C.A. 1).
>
> "However meritorious an invention may be, and however much it may contribute to the development of the art or science to which it re-

> lates, the protection afforded by a patent thereon is confined to its disclosures."
> *Price-Trawick, Inc.* v. *Gas Lift Corp.*, 101 F. (2d) 134, 136-137 (C.C.A. 5).
>
> "The monopoly granted to the inventor is defined by the claims of his patent."
> *Metal Cutting Tool Service* v. *National Tool Co.*, 103 F. (2d) 581, 584 (C.C.A. 6).
>
> "It is thoroughly well established that the patentee is limited to his claims, and the patent is no broader than the claims, and, if the language of claims of the patent is clear and distinct, the patentee is bound by the language he has employed."
> *Wilson & Willard Mfg. Co.* v. *Union Tool Co.*, 249 Fed. 729, 734 (C.C.A. 9).

4. The conflicting opinion and decision of the Circuit Court of Appeals in this case applies a principle of great importance in the administration of the patent law, and substitutes for the statutory patent document an undefinable area of monopoly, a "conception" which no man could measure.

5. The growing economic embrace of a patent demands that its grasp be expressly defined and that its terms be not distended by vague considerations foreign to the grant itself.

In this case, as is evident from the brief fragments* of the opinion of the Court of Appeals quoted above, that Court gave the claims of the patent in suit a "scope" not measured by the claims but expanded to an immeasurable, but liberal, content because the Court ascribed to the patentee the discovery of a principle not mentioned in the patent.

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* A more extended statement of the facts appears in the Petition for the Writ of Certiorari and is not repeated here.

If patents are to be accorded these hidden, unexpressed values, their limits varied with the accordion-like "conception" that may thus be contrived, they will become monopolies never contemplated by law, never granted, and never detected by those who would sincerely avoid trespassing upon them.

Wherefore Petitioner prays that a rehearing be granted of its Petition for a Writ of Certiorari, and that Writ issue.

Respectfully submitted,

HORACE DAWSON,
CASPER W. OOMS,
Attorneys for Petitioner.

Chicago, Illinois,
March 22, 1948.

Certificate of Counsel.

I hereby certify that this Petition for Rehearing is presented in good faith and not for delay and is restricted to the grounds above specified.

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Attorney for Petitioner.